

REMARKS

Claims 1-51 remain pending in the instant application. Reconsideration of the pending claims is respectfully requested.

Examiner's Inquiry Regarding Election/Restriction

In regards to claims 49-51, the Examiner states:

The embodiment of claims 49-51 does not appear to be the same invention defined by claims 1-48. For example, claim 49 appears related to allocating MPLS labels for an equivalence class (FEC), whereas, the remaining claims deal with reading/writing labels. In response to this inquiry applicant must indicate how the embodiments of claims 1-48 and 49-51 are related and indicated that they are not separately useable. Applicant may want to consider dividing out claims 49-51 or amending to be within the scope of the remaining claims.

(Office Action mailed 5/19/2006, page 2)

Accordingly, Applicants provisionally elect to continue prosecuting claims 1-48 in the instant application, pending the Examiner issuing a restriction requirement.

Examiner's Request for Information under 37 C.F.R. § 1.105

In regards to the independent claims of the instant application, the Examiner states:

The examiner requests...any documentation known to qualify as prior art under 35 U.S.C. sections 102 or 103 with respect to the invention as defined by the independent(s) claims. ... Furthermore, if applicant has knowledge of/been made aware of an assertion...that a prior art element/device corresponds to or anticipates a presently claimed limitation then such assertion must be provided to the examiner. ... This request does not require a search. ...

(Office Action mailed 5/19/06, pages 2-3; emphasis in original)

Applicants believe that any factual information that may be material to the patentability of the instant application and known to Applicants, the assignee, or those

individuals identified under 37 C.F.R. § 1.56(c) has been provided in the Information Disclosure Statement (“IDS”) filed 12/05/2003. However, the Applicant’s attorney of record has attempted to contact the inventor (whose last known residence was in Bangalore, India) twice in the last two months to ask whether any additional prior art has come to his attention since the IDS filed 12/05/2003. At the time of this response, there is no additional information to be provided to the Examiner.

Examiner’s Request to Identify Claim Limitations in Prior Art

In regards to the independent claims, the Examiner also states:

In the event documentation...is determined to qualify as prior art, a discussion of relevant passages, figs, etc. with respect to the claims must be provided. That is, for at least each **independent** claim limitation...identify a corresponding prior art element by page, line and/or fig. ... Additionally, the examiner requests identification of all present independent claim limitations...corresponding to prior art elements in the IDS documentation filed 12/05/2003. ... For each claim limitation, state whether or not it corresponds to a prior art element and identify in the art by page, line, and/or fig.

(Office Action mailed 5/19/2006, pages 3-4; emphasis in original)

In view of the Examiner’s statement, the Applicant’s understanding of the nature of the Examiner’s request is that the Examiner is requesting the Applicant to render an element-by-element determination of novelty for the independent claims of the instant application.

Applicants respectfully submit that identifying prior art elements that correspond to each element of the claims requires Applicants to formulate element-by-element opinions of novelty. The act of identifying a corresponding prior art element for each limitation of the independent claims requires interpretation of the claim limitations and interpretation of the prior art elements. These interpretations of the claim limitations or

the prior art are a matter of opinion, not a factual determinations, as even a single word in a claim limitation is routinely interpreted differently by Examiners than by Applicants.

Accordingly, based on MPEP § 704.11, which states that “requirements under 37 CFR § 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant,” Applicants respectfully decline to identify for each limitation of the independent claims a corresponding element in documentation determined to qualify as prior art or the prior art in the IDS documentation filed 12/05/2003.

Examiner’s Request for Showing of Support for Any Independent Claim Language

Lacking Antecedent Basis in Descriptive Portion of Specification

In regards to the independent claims, the Examiner further states:

The examiner also requests...a showing of support for the following: All claim language (original independent claim(s) only) that does not have antecedent basis in the descriptive portion of the specification. ... Indicate support for the claim language/limitation(s) above...by specifically pointing to page(s) and line no(s). in the specification and/or drawing figure(s) and the corresponding limitation.

(Office Action mailed 5/19/2006, pages 4-5)

Applicants respectfully submit that there is antecedent basis in the descriptive portion of the specification for the limitations of all the independent claims. In particular, the antecedent basis for the limitations of independent claims 1, 10, 22, 32, and 41 can be found in the Detailed Description portion of the specification in paragraphs 0071, 0072, and 0074, and in blocks 710, 720, and 725 of Figure 7. Likewise, the antecedent basis for the limitations of independent claim 49 can be found

in the Detailed Description portion of the specification in paragraphs 0067 and 0068, and in blocks 610 and 620 of Figure 6.

CONCLUSION

In view of the foregoing remarks, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 292-8600 if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Date: Aug. 16, 2006

A handwritten signature in dark ink, appearing to read 'Cory G. Claassen', is written over a horizontal line.

Cory G. Claassen
Reg. No. 50,296
Phone: (206) 292-8600